

## REMARKS

### I. Introduction

Claims 1-18 are pending in the application. Claims 1, 14, and 16-17 are independent. The Examiner has imposed a restriction requirement in this case. In particular, the Examiner states:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a method of providing an entitlement, classified in class 705, subclass 14.
- II. Claims 14-15, drawn to vending a first product, classified in class 700, subclass 232.
- III. Claim 16, drawn to a method of providing a benefit offer via a website, classified in class 705, subclass 26.
- IV. Claims 17-18, drawn to a method of dispensing a payment refund and a desired product, classified in class 700, subclass 240.

Office Action, pg. 2, lines 2-11; emphasis added.

The Examiner goes on to state that the "inventions" of Groups I and II "are related as **subcombinations** disclosed as usable together in a single combination." Office Action, pg. 2, bullet 2; emphasis added.

The Examiner further goes on to state that the "inventions" of Groups I and III "are directed to an **unrelated product and process**." Office Action, pg. 3, bullet 3; emphasis added.

The Examiner further goes on to state that the "inventions" of Groups I and IV "are related as **subcombinations** disclosed as usable together in a single combination." Office Action, pg. 3, bullet 4; emphasis added.

The Examiner further goes on to state that the "inventions" of Groups II and III "are directed to an **unrelated product and process**." Office Action, pg. 4, bullet 5; emphasis added.

The Examiner further goes on to state that the "inventions" of Groups II and IV "are related as **subcombinations** disclosed as usable together in a single combination." Office Action, pg. 4, bullet 6; emphasis added.

The Examiner further goes on to state that the "inventions" of Groups III and IV "are directed to an **unrelated product and process**." Office Action, pg. 5, bullet 7; emphasis added.

Applicants provisionally elect to prosecute **Group I** (which, according to the Examiner, includes claims **1-13**). This provisional election is made with **traverse**. That is, Applicants respectfully disagree with the Examiner's proposed restriction.

Applicants hereby request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

## **II. Establishing a *Prima Facie* Case for Restriction**

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

### **A. Proper Basis for Restriction**

#### **1. Generally**

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. MPEP §802.01. The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". MPEP §§802.01, 806.06. To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". MPEP §808.01. The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". *Id.* To establish a *prima facie* case for restriction where the

basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". MPEP §808.01.

## 2. Subcombinations Usable Together

In some cases, claims may be directed to subcombinations disclosed as usable together. To support a restriction requirement for claims directed to subcombinations usable together, the Examiner must show that the subcombinations are (i) "separately usable", (ii) the "subcombinations do not overlap in scope", and (iii) the subcombinations "are not obvious variants". MPEP §806.05(d). Where an Applicant presents claims directed to plural subcombinations disclosed as "usable together in a single combination and claims a combination that requires the particulars of" one of the subcombinations, "both two-way distinctness and reasons for insisting on restriction are necessary". *Id.* For restriction to be proper in such a case, the Examiner must show that "[e]ach subcombination is distinct from the combination as claimed". *Id.* Such distinctness is established if the Examiner shows: "(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination." *Id.* Further:

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

MPEP §806.05(d).

## B. The Examiner's Case as Set Forth

The Examiner, in this case, provides no argument, reasoning, or evidence that there is some reason that the pending claims should be restricted. The most the Examiner does is cite limitations from one claim that are not found in another claim as alleged 'evidence' that the claimed embodiments are mutually exclusive.

## C. No *Prima Facie* Case – "Independent" Restriction

The Examiner alleges that the claim of Group III is an "independent" invention with respect to all other alleged Groups. Applicants respectfully assert that for a restriction based on "independent" inventions, the *prima facie* burden has not been met. Applicants respectfully point out that "independent" inventions, as defined in restriction practice, are "not connected in design, operation, or effect." MPEP §§802.01, 806.06. An example of "independent" inventions would be claims directed to both "an article of clothing and a locomotive bearing". MPEP §806.06. Clearly, where all currently claimed embodiments are associated with providing entitlements and/or benefits via vending machine, **no such independence exists.**

## D. No *Prima Facie* Case – "Distinct" Restriction

If the Examiner had intended to impose the restriction based on "distinct" inventions, the *prima facie* burden has not been met. No reasons for believing the separate alleged groups of claims are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." *Id.*

**E. No *Prima Facie* Case – "Subcombinations Usable Together"****Restriction**

The Examiner has not met the *prima facie* burden for restriction. For example, the Examiner has not shown "both two-way distinctiveness" nor provided "reasons for insisting on restriction." MPEP §806.05(d). Nor has the Examiner properly addressed the three (3) requirements for establishing distinctness between subcombinations disclosed as usable together.

With respect to the first requirement that the subcombinations be separately usable (MPEP §806.05(d)), the Examiner merely recites limitations of the claims. Office Action, pg. 2, bullet 2. The Examiner provides no evidence, argument, nor support for why, or how, the alleged subcombinations are believed to be separately usable. Accordingly, **restriction in this case is not proper.**

The Examiner entirely ignores the second requirement that the subcombinations do not overlap in scope (MPEP §806.05(d)). The Examiner provides no evidence, argument, nor support for why, or how, the alleged subcombinations are believed to not overlap in scope. Applicants respectfully note that at least some of the restricted claims from Group I and Group II do indeed overlap in scope. All claims from each Group, for example, are directed to providing benefits via a vending machine. Accordingly, **restriction in this case is not proper.**

The Examiner also entirely ignores the third requirement that the subcombination be non-obvious variants (MPEP §806.05(d)). The Examiner provides no evidence, argument, nor support for why, or how, the alleged subcombinations are believed to be non-obvious variants. Accordingly, **restriction in this case is not proper.**

**F. The Examiner has Failed to Establish an Undue Burden**

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." MPEP §803. Applicants respectfully assert that restriction is not proper in this case because

there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged claim groups which would necessitate a separate field of search; (2) the alleged claim groups can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged claim groups are not related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02.

In general, Applicants believe that all pending claims can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction, restriction would still not be proper in this case.

Further, Applicants respectfully note that all claims from Groups I and II have **already been searched and examined together**. Accordingly, there **can be no burden** (much less serious burden) in this case, and restriction is thus not proper.

### III. Conclusion

In view of the foregoing, Applicants respectfully request that the restriction requirement be **withdrawn** upon reconsideration. All pending claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims. Applicants' silence with respect to any comments made in the Office Action does not imply agreement with those comments.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-438-6867 or via e-mail at [cfincham@finchamdowns.com](mailto:cfincham@finchamdowns.com), at the Examiner's convenience.

### IV. Fees and Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month extension** of time and authorize the charge of **\$130.00** to Applicants' Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Applicants' Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Amendment timely, and please charge any required fee to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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